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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/987,040  | 11/13/2001  | Craig Priest         | 13808               | 6305             |
| 293   | 7590        | 06/06/2007           | EXAMINER            |                  |
| Ralph A. Dowell of DOWELL & DOWELL P.C.<br>2111 Eisenhower Ave<br>Suite 406<br>Alexandria, VA 22314 |             |                      | BLAIR, DOUGLAS B    |                  |
|   |             | ART UNIT             |                     | PAPER NUMBER     |
|   |             | 2142                 |                     |                  |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

|                              |                              |                     |
|------------------------------|------------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b>       | <b>Applicant(s)</b> |
|                              | 09/987,040                   | PRIEST ET AL.       |
|                              | Examiner<br>Douglas B. Blair | Art Unit<br>2142    |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 23 April 2007.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 17-21,23-25 and 27-34 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 17-21,23-25, and 27-34 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
     Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. Claims 17-21, 23-25, and 27-34 are currently pending in this application. Claim 17 has been amended.

### ***Response to Arguments***

2. Applicant's arguments, see Remarks, filed 4/23/2007, with respect to the rejection(s) of claim(s) 17 under 35 USC section 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of 35 USC section 103.
3. The rest of the applicant's arguments filed 4/23/2007 have been fully considered but they are not persuasive. The applicant argues that Sutcliffe does not disclose or suggest allowing (or restricting) non-paying users access to only those stored greeting/messages of paying users while allowing paying users access to all of the greetings/messages. However, the Examiner disagrees with this argument. In Sutcliffe the user must pay for stamps to initiate communications. Thus the user paying for the stamps is the "paying user". In Sutcliffe, a non-paying user will never be allowed to receive a message from another non-paying user and a paying user will be able to receive all greetings. The fact that in Sutcliffe all "greetings" are only those from paying users is irrelevant. Notice that claim 32 is the only claim that stipulates a paying user receiving a greeting from a non-paying user but claim 32 is broad enough to cover a non-paying user sending a random email to the paying user. Sutcliffe still reads on claim 32 because Sutcliffe

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does not preclude the paying user from receiving a greeting from the non-paying user though it may be unlikely to happen in the Sutcliffe system.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 23-24, and 27-34 are rejected under 35 U.S.C. 102(a) and (e) as being anticipated by U.S. Patent Number 6,052,122 to Sutcliffe et al..

6. Sutcliffe teaches a method of operating a message exchange device (as in exemplary claim 23) comprising: storing greetings originating with each of a plurality of users using said message exchange device (col. 9, lines 25-48); obtaining from each of said plurality of users an indicator of whether that user wishes to pay to use said message exchange device, thereby classifying each of said plurality of users as a paying or non-paying user (col. 4, lines 9-10 and col. 6, lines 34-67, the “stamps” indicate whether or not a user has paid for service.); allowing paying users access to all of said stored greetings (col. 4, lines 9-10 and col. 6, lines 34-67); allowing non-paying users access to only those greetings originating with paying users (col. 4, lines 9-10 and col. 6, lines 34-67, user’s can only contact other users by using their “stamps”); calculating costs of using said message exchange device for each of said paying users based on

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time each of said paying users uses said message exchange device (col. 4, lines 9-10 and col. 6, lines 34-67, the stamps provide a measure of time in that a user that uses more stamps uses more time.).

7. The rest of the independent claims are also taught by Sutcliffe. Claim 27 features a message exchange server that performs a similar method to claim 23 and Sutcliffe teaches a message exchange server (Server 18 in Figure 1). Claim 30 features instructions for causing a message exchange server to perform the method of claim 23. Claim 31 features a similar method to claim 23. Claims 32 and 33 feature the same method as in claim 23.

8. As to claims 24 and 28, Sutcliffe teaches a method wherein greetings comprise voice messages and allowing paying users comprises allowing paying users to listen to all of the stored greetings (col. 9, lines 25-48).

9. As to claim 29, Sutcliffe teaches a server with memory that stores an amount representative of prepayment of users paying to use said server (col. 4, lines 9-10 and col. 6, lines 34-67).

10. As to claim 34, Sutcliffe teaches a method wherein measuring use of a device comprises measuring the number of greeting each paying user has accessed (col. 9, lines 24-48).

### *Claim Rejections - 35 USC § 103*

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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12. Claims 17, 19, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,594,502 to Koester in view of U.S. Patent Number 6,052,122 to Sutcliffe et al..

13. As to claim 17, Koester teaches a method of operating a device providing a service allowing a plurality of users to communicate with each other by exchanging messages, comprising: for each of said plurality of users determining if said each of said plurality of users wishes to pay for use of said service (**col. 2, lines 61-64, the subscribing users who store information are considered the “paying users”**), and thereby identifying each of said users as a paying user or a non-paying user (**col. 2, lines 64-67, the potential dater are considered the non-paying users. Note that the reference says the potential dater can be charged so that does not mean they have to be charged. For the purposes of this rejection the embodiment where the potential dater are not charged is being used to reject this claim**); allowing paying users to communicate with all of said plurality of users (**the subscribing users can communicate with anyone who contacts them**); restricting non-paying users from initiating communication with other non-paying users, while allowing non-paying users to initiate communication with paying users (**the potential dater can only initiate communications with the subscribing users**); however Koester does not explicitly teach calculating costs of said service for each of said playing users, based on time each of said paying users.

Sutcliffe teaches a method of operating a device providing a service allowing a plurality of users to communicate with each other by exchanging messages including calculating costs of said service for each of said playing users, based on time each of said paying users (**col. 4, lines**

**9-10 and col. 6, line 46, the stamps provide a measure of time in that a user that uses more stamps uses more time.).**

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Koester regarding a dating system that does not allow non-paying users to contact other non-paying users while allowing paying users to communicate with all users with the teachings of Sutcliffe regarding payments based on a measured amount of time using the system because such a system allows a user to pay for only what they actually use.

14. As to claim 19, Koester teaches a method of permitting users to exchange messages in near real-time (**col. 2, lines 54-55, an instant message**).

15. As to claim 21, Koester teaches a method wherein the device comprises a telephone interface and a storage medium, wherein said method comprises exchanging saved messages between said users (**col. 2, lines 49-55, any of the message types read on the saved messages**).

16. Claims 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,594,502 to Koester in view of U.S. Patent Number 6,052,122 to Sutcliffe et al. in further view of U.S. Patent Number 6,865,161 to Sponaugle et al.

17. As to claim 18, the Koester-Sutcliffe makes the method of claim 17 obvious, however the Koester-Sutcliffe combination does not teach bridging a call between a plurality of users.

Sponaugle teaches a method of bridging a call between a plurality of users of message exchange device (**col. 5, lines 8-44**) in the context of a dating service (**col. 8, lines 25-42**).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the applicant's invention to combine the teachings of the Koester-Sutcliffe combination

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regarding the management of a message exchange system with the teachings of Sponaugle regarding the bridging of a telephone call because voice communication enhances a users ability to communicate.

18. As to claim 20, both the cited portions of the Koester, Sutcliffe, and Sponaugle references discuss collecting fees before providing services.

19. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,052,122 to Sutcliffe et al. in view of U.S. Patent Number 6,865,161 to Sponaugle et al..

20. As to claim 25, Sutcliffe teaches the method of claim 23, however Sutcliffe does not teach bridging a call between a plurality of users.

Sponaugle teaches a method of bridging a call between a plurality of users of message exchange device (col. 5, lines 8-44) in the context of a dating service (col. 8, lines 25-42).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the applicant's invention to combine the teachings of Sutcliffe regarding the management of a message exchange system with the teachings of Sponaugle regarding the bridging of a telephone call because voice communication enhances a users ability to communicate.

### ***Conclusion***

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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22. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas B. Blair whose telephone number is (571) 272-3893. The examiner can normally be reached on 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Douglas Blair

DBB

Andrew Caldwell

ANDREW CALDWELL  
SUPERVISORY PATENT EXAMINER